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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/735,349	12/11/2003	Michael D. Laufer	436565-018	3758
46188	7590	10/13/2010		
Nixon Peabody LLP P.O. Box 60610 Palo Alto, CA 94306			EXAMINER STEPHENS, JACQUELINE F	
			ART UNIT 3761	PAPER NUMBER
			MAIL DATE 10/13/2010	DELIVERY MODE PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/735,349

Applicant(s)

LAUFER ET AL.

Examiner

Jacqueline F. Stephens

Art Unit

3761

Period for Reply -- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 02 August 2010.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 55-60 and 92-112 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 55-60, 92-112 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-8508)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

DETAILED ACTION

Response to Arguments

1. Applicant's arguments filed 8/2/10 have been fully considered and are not persuasive. With respect to the rejection of claims 55-60 as being anticipated by Bass reference, Applicant argues Bass does not disclose cutting fat that has extruded through at least one hole in a non-convex surface on a side of the surface opposite the fatty tissue. Applicant argues Bass removes fat through cauterization, not cutting as presently claimed. However, what is claimed is "said step of cutting said fat further comprises cutting said fat with an electrocautery cutting element", claim 57. Bass teaches cutting fat with an electrocautery cutting element (paragraph 0078). Electrocautery is a known technique for cutting removing or shaving tissue as taught for example in Adams USPN 6503263 (col. 7, lines 28-34).

Claim Rejections - 35 USC § 102

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

3. Claims 55-60, 95-100 are rejected under 35 U.S.C. 102(e) as being anticipated by Bass US Patent Application Publication 2003/0176851.

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4. As to claims 55, 56, 57, 95-97, and 96, Bass teaches a method of removing fatty tissue while protecting nerves, comprising the steps: exposing a portion of said fatty tissue; pressing said fatty tissue with a non-convex surface having at least one hole (paragraph 0024-0026); extruding fat through said at least one hole, the hole being dimensioned to allow fat cells to extrude through while preventing nerves from passing therethrough (paragraph 0026, 0041, 0049, 0078-0079) and cutting said fat that has extruded through said hole on a side of said surface opposite said fatty tissue (paragraph 0026, 0081, 0083). Bass teaches employing an electrocautery element for the benefits of providing faster and more complete fat removal and well as producing less bruising, less blood, and faster recovery (paragraph 0026). Electrocautery is a known technique for cutting removing or shaving tissue as taught for example in Adams USPN 6503263 (col. 7, lines 28-34).

As to claims 58 and 98, Bass teaches heating said fatty tissue at a time selected from the group consisting of prior to said cutting step, during said cutting step, and both prior and during said cutting step (paragraph 0022, 0040)

As to claims 59 and 99, the step of pressing said fat layer further comprises pressing with a surface having at least one hole 18 located on a distal most end 14 of a cannula 12 (paragraph 0043, Figure 1).

As to claims 60 and 100, the step of pressing the fat layer further comprises pressing

with a surface having at least one hole located proximal of a distal most end of a cannula (pp 0043, 0044, 0047).

Claim Rejections - 35 USC § 103

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 92-94 and 101-103 are rejected under 35 U.S.C. 103(a) as being unpatentable over Bass US Patent Application Publication 2003/0176851. Bass teaches the present invention substantially as claimed. Bass does not teach the claimed diameter of the hole and relationship to extruded distance. However, Bass teaches the general conditions of cutting and extruding the fat through a hole on a side of the surface opposite the fatty tissue, which obviously involves a hole diameter and a distance of the extruded tissue, with a relationship of the diameter to the distance (paragraph 0026, 0081, 0083). Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to provide the invention of Bass with the claimed hole diameter and ratio, since where the general conditions of a claim are disclosed in the prior art, it is not inventive to discover the optimum or workable ranges by routine experimentation, In re Aller et al. 105 USPQ 233.

6. Claims 104-112 are rejected under 35 U.S.C. 103(a) as being unpatentable over Bass US Patent Application Publication 2003/0176851 in view of Halverson USPN 6071260.

As to claims 104-106, see the rejection of claim 55 supra. Bass does not specifically teach a scraper. Halverson teaches a method of removing fat involving scraping (col. 7, lines 13-18). Halverson teaches scraping can be used in conjunction with ultrasonic methods. One having ordinary skill in the art at the time the invention was made would have been motivated to incorporate scraping since it provides an alternative or more thorough method of removing fat material when used in conjunction with ultrasonic methods.

As to claim 107, Bass teaches heating said fatty tissue at a time selected from the group consisting of prior to said cutting step, during said cutting step, and both prior and during said cutting step (paragraph 0022, 0040)

As to claim 108, the step of pressing said fat layer further comprises pressing with a surface having at least one hole 18 located on a distal most end 14 of a cannula 12 (paragraph 0043, Figure 1).

As to claim 109, the step of pressing the fat layer further comprises pressing with a surface having at least one hole located proximal of a distal most end of a cannula (pp 0043, 0044, 0047).

As to claims 110-112, Bass/Halverson teaches the present invention substantially as claimed. Bass/Halverson does not teach the claimed diameter of the hole and relationship to extruded distance. However, Bass/Halverson teaches the general conditions of cutting and extruding the fat through a hole on a side of the surface opposite the fatty tissue, which obviously involves a hole diameter and a distance of the extruded tissue, with a relationship of the diameter to the distance (Bass paragraph 0026, 0081, 0083). Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to provide the invention of Bass/Halverson with the claimed hole diameter and ratio, since where the general conditions of a claim are disclosed in the prior art, it is not inventive to discover the optimum or workable ranges by routine experimentation, *In re Aller* et al. 105 USPQ 233.

Conclusion

7. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the

shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jacqueline F. Stephens whose telephone number is (571) 272-4937. The examiner can normally be reached on Monday-Friday 9:00-5:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Tanya Zalukaeva can be reached on (571) 272-1115. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Jacqueline F Stephens/

Primary Examiner, Art Unit 3761